II. General Remarks Concerning This Response

Claims 1, 2, 4-7, 12, 13, 15-18, 23, 24, and 26-29 are currently pending in the present application. Claims 1, 4-7, 12, 15-18, 23, and 26-29 have been amended; no claims have been added; and claims 3, 8-11, 14, 19-22, 25, and 30-33 have been canceled in this response. Reconsideration of the claims is respectfully requested.

III. 35 U.S.C. § 102(a)—Anticipation—*Gnutella*

The Office action has rejected claims 1, 2, 5-7, 12, 13, 16-18, 23, 24, and 27-29 under 35 U.S.C. § 102(a) as anticipated by "Gnutella Support", from gnutella.wego.com, 12/31/1999 (Gnutella). This rejection is respectfully traversed.

The Office action admits on page 8, albeit within the obviousness rejection, that Gnutella "does not explicitly disclose node characterizing data contains an information classification for data available to be shared by the target node". In response to the anticipation rejection, Applicant has amended each of the independent claims to include a feature that the Office action admits is not disclosed by Gnutella, i.e. "wherein the node characterizing data contains information classification data for content data that is available from the target node". More specifically, independent claim 1 has a second element that recites (emphasis added):

> receiving means for receiving node characterizing data from the target node, **wherein the node characterizing data contains information classification data for content data that is available from the target node**, wherein the information classification data indicates multiple categories into which content data that is available from the target node has been classified;

Independent claim 1 is directed to a method; claim 12 is directed to an apparatus; and claim 23 is directed to a computer program product. The Office action uses an anticipation argument against claims 12 and 23 by relying the argument that is used

against claim 1. Applicant's argument is applicable for each of the independent claims. Given that the dependent claims incorporate the features of the independent claims from which they depend, Applicant's argument is also applicable against the rejection of the dependent claims.

5

Gnutella clearly does not disclose features as required by the language of the claims of the present application. As stated at MPEP § 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

10

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,

15

1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Hence, for this and other reasons, Gnutella cannot be used as an anticipatory reference, and the anticipation rejection of the claims has been overcome, whereby Applicant requests the withdrawal of the rejection.

20

IV. 35 U.S.C. § 103(a)—Obviousness—*Gnutella* in view of *Anderson*

The Office action has rejected claims 3, 4, 8-11, 14, 15, 19-22, 25, 26, and 30-33 under 35 U.S.C. § 103(a) as unpatentable over Gnutella in view of Anderson, "Method and apparatus for

25

information retrieval from a network using parameter value sampling", U.S. Patent Number 6,427,165 B1, filed 11/18/1998, issued 07/30/2002. This rejection is traversed.

The Office action admits on page 8 that Gnutella "does not explicitly disclose node characterizing data contains an

30

information classification for data available to be shared by the target node". The obviousness rejection then turns to Anderson for disclosure of certain features. In response to the obviousness rejection, Applicant has amended each of the

independent claims to include a feature that is not disclosed by Anderson, i.e. "wherein the information classification data indicates multiple categories into which content data that is available from the target node has been classified". More

5   specifically, independent claim 1 has a second element that recites (emphasis added):

> receiving means for receiving node characterizing data
> from the target node, wherein the node characterizing data
> contains information classification data for content data
> that is available from the target node, **wherein the
> information classification data indicates multiple
> categories into which content data that is available from
> the target node has been classified;**

10

15   Anderson only discloses the use of a summary of the information that is available from a node, whereas the amended claims now more clearly recite that the available information is classified by indicating multiple categories into which the available content data is classified; the amended feature is not disclosed

20   in Anderson.

Additional features have also been added to the amended dependent claims that are also not disclosed in Anderson. For example, dependent claims 4, 15, and 26 now recite that the content data that has been classified includes content data at

25   the target node and at nodes from which the target node is able to retrieve data. Dependent claims 5, 16, and 27 now recite that the information classification data includes information classification data that has been received by the target node; as explained in the specification of the present patent application,

30   the nodes in the peer-to-peer network are able to share information about themselves and the nodes from which they have received information, thereby providing an information topology that allows the user to see which node has better connnections to other nodes with respect to particular information categories.

35   Dependent claims 6, 17, and 28 now recite a similar feature to claims 5, 16, and 27 except that the information classification

data has been gathered to a certain depth, i.e. a certain number of links away from the target node. Dependent claims 7, 18, and 29 now recite that the node characterizing data includes an indication of the depth of the links to other nodes from which
5   the target node has collected the information classification data.

Examiner bears the burden of establishing a *prima facie* case of obviousness

10   The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant
15   to produce evidence of nonobviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled
20   to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). In response to an assertion of obviousness by the Patent Office, the applicant may attack the Patent Office's *prima facie* determination as
25   improperly made out, present objective evidence tending to support a conclusion of nonobviousness, or both. *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

Gnutella and Anderson clearly fail to disclose at least one feature of the present invention as recited within each
30   independent claim, notwithstanding the anticipation and obviousness arguments presented by the Office action, thereby rendering Gnutella and Anderson incapable of being used as primary and secondary references as argued by the current

rejection. Moreover, a hypothetical combination of <u>Gnutella</u> and <u>Anderson</u> would also fail to reach the claimed invention of the present patent application. As should be recognized, because both the primary and secondary references in the rejection fail

5   to disclose or suggest the claimed features against which the references were applied, and because the references fail to be combinable to produce these claimed features, the rejection fails to fulfill the requirements of a proper obviousness argument.
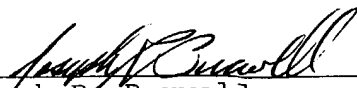
With respect to the claims of the present patent

10   application, Applicant respectfully submits that it would not have been obvious for one having ordinary skill in the art to have used the applied prior art references to reach the claimed invention. Hence, a rejection of the claims cannot be based upon the cited prior art to establish a *prima facie* case of

15   obviousness. Therefore, a rejection of the claims under 35 U.S.C. § 103(a) has been shown to be insupportable in view of the cited prior art, and the claims are patentable over the applied references. Applicant respectfully requests the withdrawal of the rejection of the claims.

20

V.   **Conclusion**

It is respectfully urged that the present patent application is patentable, and Applicant kindly requests a Notice of Allowance.

For any other outstanding matters or issues, the examiner is urged to call or fax the below-listed telephone numbers to expedite the prosecution and examination of this application.

5   DATE: <u>September 13, 2004</u>   Respectfully submitted,

_____
Joseph R. Burwell
Reg. No. 44,468
10   ATTORNEY FOR APPLICANT

Law Office of Joseph R. Burwell
P.O. Box 28022
Austin, Texas 78755-8022
15   Voice: 866-728-3688 (866-PATENT8)
Fax: 866-728-3680 (866-PATENT0)
Email: joe@burwell.biz